

### REMARKS

Claims 1-4 are pending in the application. Claim 3 has been amended to correct a typographical error pointed out by the Examiner.

Applicants submit herewith an English language translation of Japanese Patent Application 10/93625 (the “‘625 application”), filed on April 6, 1998, and Verification of Translation. It is understood that the foregoing perfects Applicants’ foreign priority claim to the ‘625 application under 37 C.F.R. § 1.55 and 35 U.S.C. § 119. Applicants submit that the present claims should now be accorded an earliest effective filing date of April 6, 1998.

#### Rejections under 35 U.S.C. § 102

Claims 1, 2, and 4 are rejected under 35 U.S.C. § 102(a) as being anticipated by Yamasaki et al., WO 98/15530 (Yamasaki).

Applicants respectfully disagree.

The present application is entitled to benefit of priority under 35 U.S.C. § 119 of PCT/JP99/01798, filed on April 5, 1999 and the ‘625 application, filed on April 6, 1998.

The publication date of Yamasaki is April 16, 1998. Applicants therefore submit that Yamasaki does not qualify as prior art under 35 U.S.C. 102(a) because the priority date of the present application, April 6, 1998, antedates the publication date of Yamasaki, April 16, 1998. Applicants respectfully request that the rejection of claims 1, 2, and 4 be withdrawn for the reasons set forth above.

Claims 1, 2, and 4 are rejected under 35 U.S.C. § 102(e) as being anticipated by Pamakcu et al., U.S. Patent 6,410,584 (the “‘584 patent”). According to the Examiner, the ‘584 patent “disclose, for example, compound 93 (see Figure 13), which anticipates the instant claims” (Office Action, page 3).

Applicants respectfully disagree.

The ‘584 patent issued on June 25, 2002. The application that issued as the ‘584 patent, United States Application No.: 09/199,860 (the “‘860 application”), was filed on November 25, 1998 and is a continuation-in-part of United States Application No.: 09/007,098 (the “‘098

application”), filed on January 14, 1998 (now U.S. Patent 6,046,199, the “199 patent”). Thus, only the filing date of the ‘098 application, January 14, 1998, is earlier than the priority date of the present application.

However, none of the species disclosed in the ‘584 patent (including compound 93) are taught or suggested in the ‘199 patent. As such, the species disclosed in the ‘584 patent (including compound 93) are only entitled to the filing date of the ‘860 application, November 25, 1998. Applicants submit that the ‘584 patent does not qualify as prior art under 35 U.S.C. 102(e) because the priority date of the present application, April 6, 1998, antedates the earliest effective filing date that can be accorded to the anticipatory subject matter disclosed in the ‘584 patent, i.e., November 25, 1998. Applicants respectfully request that the rejection of claims 1, 2, and 4 be withdrawn for the reasons set forth above.

Rejections under 35 U.S.C. § 103(a)

Claims 1-4 are rejected as being unpatentable over Yamasaki and the ‘584 patent. Applicants respectfully request that these rejections be withdrawn for the reasons set forth above.

Applicant : Noritsugu Yamasaki et al.  
Serial No. : 09/647,772  
Filed : October 4, 2000  
Page : 6 of 6

Attorney's Docket No.: 14878-065001 / D1-002PCT-  
US

CONCLUSION

Applicants submit that all claims are in condition for allowance.

Enclosed is a \$110 check for the One-Month Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050, referencing Attorney Docket No.: 14878-065001.

Respectfully submitted,

Date: December 2, 2004

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